

REMARKS

Claims 1-76 are pending in the application.

Claims 1-76 have been rejected.

Rejection of Claims under 35 U.S.C. § 103

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. § 103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Claims 1, 11, 14, 20, 30, 33, 39, 49, 52, 58, 68, and 71: Independent Claims 1, 20, 39, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent Application 2004/0205452 A1 filed by Fitzsimons et al. (“Fitzsimons”) in view of U.S. Patent Application 2002/0007393 A1 filed by Hamel (“Hamel”). Applicants respectfully traverse this rejection.

Each independent claim contains limitations of the form:

- “identifying an applet of the tag field-based view, wherein the applet comprises a control”;
- “modifying the control to produce a modified control”; and
- “mapping the modified control to the template”.

See, e.g., Claim 1. Applicants respectfully submit that neither Fitzsimons nor Hamel, alone or in combination, disclose each of these claim limitations.

As the Office Action admits, Fitzsimons fails to disclose the limitation “identifying an applet of the tag field-based view, wherein the applet comprises a control.” *See Final Office Action, ¶ 6.* Since Fitzsimons fails to disclose this limitation, then Fitzsimons cannot provide disclosure related to manipulating the claimed control (i.e., “modifying” or “mapping”, as claimed), since disclosure of an applet comprising the control is necessary to any manipulation of the control. Applicants further respectfully submit that the particular parts of the Fitzsimons reference the Examiner has relied upon for disclosure of the “modifying” and “mapping” limitations have not been designated as nearly as practicable, and the pertinence of the Fitzsimons reference as to those limitations has not been clearly explained, both as required by 37 C.F.R. § 1.104(c)(2). Nevertheless, Applicants have made every attempt to respond to the rejections recited in the Office Action.

The Office Action cites Hamel for the proposition that it discloses the limitation of “identifying an applet of the tag field-based view, wherein the applet comprises a control”. *See Final Office Action, ¶ 6.* Applicants respectfully submit that the cited sections of Hamel provide no such disclosure. Paragraph 81 of Hamel merely purports to disclose an applet running in a user’s browser that “can access ad content through a path consisting of link 180 to proxy 158, and link 185 between proxy 158 and ad server 160.” Cited claim 26 of Hamel relates a “java based software applet including an interactive tag associated with content located at a third party site.” Neither cited section discloses either a “tag field-based view” or a “control”, as claimed. The Office Action further makes no argument that Hamel discloses either the “modifying” or “mapping” limitations that are absent from Fitzsimons.

The Office Action does not establish the presence of the above listed limitations in either Fitzsimons or Hamel, alone or in combination. The burden is on the Examiner to support a case of obviousness, including whether the prior art references teach or suggest all of the claim limitations. *See MPEP 706.02(j).* Without such a teaching, Applicants respectfully submit that Fitzsimons in view of Hamel cannot be said to render the independent claims, or any claims dependent upon them, obvious.

In addition, Applicants respectfully submit that the Examiner has not satisfied the burden of factually supporting the alleged motivation to combine the two references. The Examiner's duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleamed from the references. The Examiner must therefore provide evidence to suggest the combination and “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *See In re Dembiczaik*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

While the Office Action states that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate an applet into Fitzsimons’ view shift in order to facilitate the transmission of ad content,” it fails to state why a person of ordinary skill would want to make this combination. In fact, Fitzsimons teaches away from such a combination. Fitzsimons is limited in application to conversion of data from one format to another. *See, e.g.*, Fitzsimons [0019] (“there exists a need for a device that will automatically generate and associate templates for the disparate media outlets, device output platforms, and media formats that automatically converts source data and formats, and generates composites in any desired output format.”). Throughout the Fitzsimons disclosure reference is only made to conversion of

source data to target data formats. *See, e.g.*, Fitzsimons [0064] & [0066]. No mention is ever made within Fitzsimons of a need or desire to include advertising content in such a data conversion process. And, as the Office Action readily admits, Fitzsimons provides no disclosure of the limitation of identifying an applet of the tag field-based view, wherein the applet comprises a control. The disclosure in Hamel is focused upon providing a mechanism for allowing click-through for a URL delivered advertisement on a web page within a java applet executing on a client machine. *See* Hamel, Abstract. The Office Action provides no citations to any section within Hamel that relate such functionality to the data conversion process of Fitzsimons, or of the desirability for such a combination.

Applicants have previously presented that a *prima facia* case of obviousness has not been established because the Office Action does not present any motivation to combine from within the references themselves. In response, the Final Office Action reiterates that “this would have been a useful feature to add on to Fitzsimons and the order of operations does not affect it.”

Applicants respectfully submit that such an argument fails to establish a *prima facia* case of obviousness. The Office Action makes no showing of a motivation to combine Fitzsimons with Hamel from within the references themselves; therefore, it must be presumed that there is none. It is well-established that the best defense to a forbidden hindsight analysis is a “rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *See Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000); *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.* 229 F.3d 1120, 1124-25 (Fed. Cir. 2000).

A showing of combinability must be “clear and particular” and “broad conclusory statements about the teaching of multiple references, standing alone, are not ‘evidence.’”

See Ruiz v A.B .Chance Co., 234 F.3d 654, 666 (Fed. Cir. 2000); *Brown & Williamson,* 229 F.3d at 1125.

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: (1) in the prior art references themselves; (2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (3) from the nature of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.”

Ruiz, 234 F.3d at 665. The Office Action presents nothing more than broad, generalized statements relating to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. The Office Action does not establish that the references which are combined are of special interest or importance in the field. Indeed, Fitzsimons is in the separate and distinct field of data conversion, rather than the field of Hamel which is related to providing advertising content. Nor does the Office Action present any evidence of a problem to be solved from within those references themselves. Instead, the Office Action fabricates such a problem to be solved, by implying that it is desirable to facilitate the transmission of advertising content when one is performing a data conversion such as that in Fitzsimons. In light of the Office Action’s attempt to generalize this to approximate the claims at issue, the only way such a problem fabrication could be performed is through exposure to the claimed invention in Applicants’ application (i.e., hindsight).

Failing to find any motivation to combine the references from within the references themselves, one can only be left with the conclusion that the Office Action is using the Applicant’s own disclosure as a blueprint for providing the motivation to

combine the prior art references, which is impermissible. *See W.L. Gore & Associates v. Garlock*, 721 F.2d 1540, 1552-53 (Fed. Cir. 1983) (“to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against it’s teacher”). Applicants therefore submit that the Office Action fails to provide a motivation to combine the prior art references that is legally permissible.

Applicants further respectfully submit that the Office Action fails to satisfy the third requirement for a *prima facia* finding of obviousness--that there be a reasonable expectation of success in the combination of stated references. Both the suggestion to combine and the expectation of success must be founded in the prior art, not in the Applicants’ disclosure. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Not only is there no suggestion to combine the references within the references themselves, as discussed above, there is no indication that such a combination of the two references would be successful in providing the claimed invention. Fitzsimons purports to relate to importing and converting source data and data format types to a target data and format types. Hamel purports to relate to displaying advertising content through the use of a java applet. Hamel provides no disclosure of conversion of the applet or data, or that such display of advertising content would aide in the conversion of data from one type to another as disclosed in Fitzsimons. Fitzsimons, likewise, does not relate the need or desirability for including advertising content during a process of converting data from one type to another, nor does it provide any information that such advertising content would aid in such a conversion. Regardless, transmission of advertising content, as disclosed in Hamel, is not related to the subject matter of the present application, nor

does Hamel provide any disclosure of controls and tag field-based views as claimed, as discussed above.

For these reasons, Applicants respectfully submit that the Final Office Action fails to present a *prima facia* case of obviousness of Independent Claims 1, 20, 39, and 58, and all claims dependent upon them, and that they are in condition for allowance. Therefore, Applicants respectfully request the Examiner's reconsideration of the final rejections to those claims and a notification of the allowability of the same.

CONCLUSION

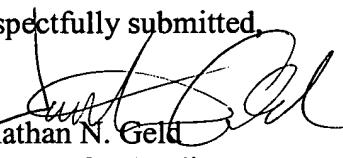
In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, COMMISSIONER FOR PATENTS, P. O. Box 1450, Alexandria, VA 22313-1450, on June 30, 2005.


Attorney for Applicant(s)


Date of Signature

Respectfully submitted,


Jonathan N. Geld
Attorney for Applicants
Reg. No. 44,702
(512) 439-5090 [Phone]
(512) 439-5099 [Fax]